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09/745,923	12/22/2000	Jarvis C. Tou	42390P9432	2870

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INTEL CORPORATION
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MINNEAPOLIS, MN 55402

EXAMINER

TRINH, TAN H

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/745,923

Applicant(s)

TOU ET AL.

Examiner

TAN TRINH

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-16,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. Patent No. 6509876) in view of Sward (U.S. Pub. No. 20030210199).

Regarding to claim 1, Jones teaches an apparatus (see fig. 1) comprising: a personal computer card (see fig. 1, computer (communication) card 16 (PCMCIA 16) and figs. 8-13, communication card 16) including communication module (see figs. 1 and 8-13, communication card 16, col. 3, lines 15-37, col. 6, lines 57-col. 7, lines 55) having an antenna unit (Figs. 1, 10-13, antenna system 12, col. 7, lines 44-col. 8, lines 5), and a spring to assist in extending the antenna unit from the communication module (see Figs. 9-10, spring 72, col. 10, lines 59-65), wherein the antennae unit is adapted to disable the communication module when in a first position and wherein the apparatus is operable when the antenna unit is in the first position. (figs. 8-9, antenna extended position 34 (second position) and retracted position 36 (first position), and figs. 2-3 and 8-9, col. 8, lines 52-col. 9, lines 34, col. 10, lines 35-44, and col. 3, lines 60-col. 4, lines 18). Jones also teaches a spring to assist in extending the antenna unit from the communication module. But Jones does not mention *a first spring for electrical contact to the antenna unit, and second spring to assist in extending the antenna unit from the communication module.*

However, Sward teaches *a first spring for electrical contact to the antenna unit, and second spring* to assist in extending the antenna unit from the communication module (see fig. 7A-B, page 3, sections [0022 and 0024] and page 8, section [0068]. Since the compression spring is provided for extending and retracting an antenna and also providing an electrical connection to the antenna).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Jones with Sward, in order to provide extending and retracting an antenna and also provide an electrical connection between the antenna and electronic device (see Sward page 3, section [0022]).

Regarding to claim 3, Jones teaches wherein the antenna unit is further adapted to enable a visual indicator when in the first position (see fig. 4-5, light source 48, col. 9, lines 35-57) and (see fig. 10, an indicator, light source 83, visual indicator when in the first position light source 83 is dark, the antenna is retracted position 36, the light 83 will turn off to indicated that the antenna system 12 is no longer operational, col. 11, lines 16-28), and (see col. 4, lines 15-18).

Regarding to claim 4, Jones teaches wherein the visual indicator comprises a light emitting diode (LED) (see fig. 10, LED light source 83).

Regarding to claim 5, Jones teaches wherein the antenna unit is further adapted to enable the communication module when in a second position (extended 34) (see fig. 8, col. 10, lines 1-34).

Regarding to claim 6, Jones teaches wherein at least a majority of the antenna unit is contained within the communication module when in the first position (see fig. 9, col. 10, lines 34-44, col. 3, lines 60-col. 4, lines 9).

Regarding to claim 7, Jones teaches wherein substantially all of the antenna unit is contained within the communication module when in the first position (see fig. 9, col. 10, lines 34-44, and col. 3, lines 60-col. 4, lines 9).

Regarding to claim 8, Jones teaches wherein the communication module comprises a radio (see fig. 1, col. 7, lines 44-col. 8, lines 37).

Regarding to claim 9, Jones teaches a portable radiotelephone adapted use in a cellular radiotelephone system to transmit and receive signals having a frequency ranging of cellular band from about 1 MHz to 900 MHz (see col. 6, lines 65-67 and col. 8, lines 6-37).

Regarding to claim 10. Jones teaches wherein the communication module comprises a personal computer memory card international association (PCMIA) card (see figs. 1, col. 7, lines 5-43)

Regarding to claim 11, Jones teaches a system (see fig. 1) comprising: a processor a static random access memory coupled to the processor (see fig. 1, col. 6, lines 57- col. 8, lines 15), the

examiner take official noticed for the static random access memory coupled to the processor is a well known in the art (see fig. 1, col. 6, lines 57- col. 8, lines 15), and a communication module (see figs. 1 and 8-13, communication card 16, col. 3, lines 15-37, col. 6, lines 57-col. 7, lines 55) having an antenna module (Figs. 1, 10-13, antenna system 12, col. 7, lines 44-col. 8, lines 5), and spring to assist in extending at least a portion of the antenna module from the communication module (see Figs. 9-10, spring 72, col. 10, lines 59-65), wherein at least the portion of the antenna unit extends from the communication module in a first position (extended position 34) to enable the communication module to transmit and receive (see figs. 1, 8 and 10-13, col. 10, lines 1-34, and col. 11, lines 39-42, lines 49-54), and wherein the portion retracts into the communication module in a second position (retracted position 36) to disable the communication module from transmitting or receiving (see figs. 2-3 and 9, col. 8, lines 52-col. 9, lines 34, and col. 10, lines 35-44), Wherein the system is still operable when the portion is in the second position (see col. 3, lines 60-col. 4, lines 18). Jones also teaches a spring to assist in extending the antenna unit from the communication module. But Jones does not mention *a first spring for electrical contact to the antenna module, and second* spring to assist in extending the antenna unit from the communication module.

However, Sward teaches *a first spring for electrical contact to the antenna module, and second* spring to assist in extending the antenna unit from the communication module (see fig. 7A-B, page 3, sections [0022 and 0024] and page 8, section [0068]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above teaching of Jones with Sward, in order to provide extending

and retracting an antenna and also provide an electrical connection between the antenna and electronic device (see Sward page 3, section [0022]).

Regarding to claim 12, Jones teaches wherein at least a majority of the antennae unit extends from the communication module when the antennae unit is in the first position (extended position 34) (see figs. 1, 8 and 10-13, col. 8, lines 54-63, col. 10, lines 1-34, and col. 11, lines 39-42, lines 49-54).

Regarding to claim 13, Jones teaches wherein the antennae unit disables the communication module when in a second position (retracted position 36) (see figs. 2-3 and 9, col. 8, lines 52-col. 9, lines 34, and col. 10, lines 35-44).

Regarding to claim 14, Jones teaches wherein at least a majority of the antennae unit is contained within the communication module when in the second position (retracted position 36) (see fig. 9, col. 3, lines 60-col. 4, lines 18).

Regarding to claim 15, Jones teaches wherein the antenna unit extends less than about 10 centimeters outward from the communication module when in the first position (extended position 34) (see fig. 8 and 10-13).

Regarding to claim 16, Jones teaches wherein the antenna unit is adapted to enable a visual indicator when in the second position (retracted position 36) (see fig. 4-5, light source 48,

col. 9, lines 35-57) and (see fig. 10, an indicator, light source 83, visual indicator when in the second position light source 83 is dark, the antenna is retracted position 36, the light 83 will turn off to indicated that the antenna system 12 is no longer operational, col. 11, lines 16-28), and (see col. 4, lines 15-18).

Regarding to claim 24, Sward teaches wherein the second spring is a compression spring (see fig. 7B, page 8, section [0068]).

3. Claim 23 is rejected under 35 U.S.C. 102(e) as being anticipated by Jones (U.S. Patent No. 6509876) in view of Sward (U.S. Pub. No. 20030210199) further in view of Vanderhelm (U.S. Patent No. 6847830).

Regarding to claim 23, Jones and Sward teaches the first spring is a compression spring. But Jones and Sward does not mention wherein the first spring is a torsion spring.

However, Vanderhelm teaches wherein the first spring is a torsion spring (see fig. 5, torsion spring 72, col. 4, lines 10-17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify above the combination of the teaching of Jones and Sward with Vanderhelm, in order to provide extending and retracting an antenna and also provide an electrical connection between the antenna and electronic device (see Sward page 3, section [0022]).

Response to Arguments

4. In response to the Applicant's Affidavit filed under CFR 1.131 to remove the Jones et al. (U.S. patent No. 6,509,876), However, the Affidavit filed under CFR 1.131 on 03-12-2007, with Exhibit A, the evidence of Exhibit A submitted is **insufficient** to establish diligence from a date prior to the date of reduction to practice of the Jones references to either a constructive reduction to practice or an actual reduction to practice. Carefully reviewing the Exhibit A evidence, the Exhibit A evidence shows only the concept of the invention should be filed for a patent. It does not discuss anything concerning about limitations recited in the claims.

5. In response to the Applicant's Affidavit filed under CFR 1.131 to remove the Jones et al. (U.S. patent No. 6,509,876), However, the Affidavit filed under CFR 1.131 on 03-12-2007, with Exhibit B filed on 09-06-2007, the evidence of Exhibit B submitted is **insufficient** to establish diligence from a date prior to the date of reduction to practice of the Jones references to either a constructive reduction to practice or an actual reduction to practice. Carefully reviewing the Exhibit B evidence, the Exhibit B evidence shows only the drawing of the simple of a PC card. It does not discuss anything concerning about limitations recited in the claims.

MPEP 715.03 [R-2] Genus-Species, Practice Relative to Cases Where Predictability Is in Question. Where generic claims have been rejected on a reference or activity which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn, subject to the rules set forth below, unless the applicant is able to establish that he or she was in possession of the generic invention prior to the effective date of the reference or activity. In other words, the affidavit or declaration under 37 CFR 1.131

must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974). And *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 125 USPQ 345 (CCPA 1960).

Regarding independent claims 1 and 11, the Exhibit A and B evidence does not support the limitation of “*a first spring for electrical contact to the antenna unit, and second spring to assist in extending the antenna unit from the communication module*” as claims 1 and 11, and also does not support the limitation of “*a processor a static random access memory coupled to the processor*” as claim 11.

Regarding claim 3, the Exhibit A and B evidence does not support the limitation of “*the antenna unit is further adapted to enable a visual indicator when in the first position*”.

Regarding claim 5, the Exhibit A and B evidence does not support the limitation of “*the antenna unit is further adapted to enable the communication module when in a second position*”.

Regarding claim 6, the Exhibit A and B evidence does not support the limitation of “*at least a majority the antenna unit is contained within the communication module when in the first position*”.

Regarding claim 7, the Exhibit A and B evidence does not support the limitation of *“substantially all of the antenna unit is contained within the communication module when in the first position”*.

Regarding claim 8, the Exhibit A and B evidence does not support the limitation of *“the communication module comprises a radio”*.

Regarding claim 9, the Exhibit A and B evidence does not support the limitation of *“a portable radiotelephone adapted use in a cellular radiotelephone system to transmit and receive signals having a frequency ranging of cellular band from about 1 MHz to 900 MHz”*.

Regarding claim 10, the Exhibit A and B evidence does not support the limitation of *“the communication module comprises a personal computer memory card international association (PCMIA) card”*.

Regarding claim 12, the Exhibit A and B evidence does not support the limitation of *“a majority of the antennae unit extends from the communication module when the antennae unit is in the first position”*.

Regarding claim 13, the Exhibit A and B evidence does not support the limitation of *“the antennae unit disables the communication module when in a second position”*.

Regarding claim 14, the Exhibit A and B evidence does not support the limitation of “*least a majority of the antennae unit is contained within the communication module when in the second position*”.

Regarding claim 15, the Exhibit A and B evidence does not support the limitation of “*the antenna unit extends less than about 10 centimeters outward from the communication module when in the first position*”.

Regarding claim 16, the Exhibit A and B evidence does not support the limitation of “*the antenna unit is adapted to enable a visual indicator when in the second position*”.

Regarding claim 23, the Exhibit A and B evidence does not support the limitation of “*the first spring is a torsion spring*”.

Regarding claim 24, the Exhibit A and B evidence does not support the limitation of “*the second spring is a compression spring*”.

In other words, the affidavit or declaration under 37 CFR 1.131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claims.

Therefore, the Affidavit filed under CFR 1.131 on 03-12-2007, with Exhibit B filed on 09-06-2007, the evidence of Exhibit B submitted is **insufficient** to establish diligence from a

date prior to the date of reduction to practice of the Jones references to either a constructive reduction to practice or an actual reduction to practice.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for Technology Center 2600 only)

Hand-delivered responses should be brought to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (571) 272-7888. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Anderson, Matthew D., can be reached at (571) 272-4177.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is (703) 306-0377.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tan H. Trinh
Division 2618
November 12, 2007

PATENT EXAMINER
TRINH, TAN

